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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,968	07/07/2003	Takao Miyazaki	Q76146	4709

7590 11/30/2004
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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Washington, DC 20037-3202

EXAMINER

NOLAN JR, CHARLES H.

ART UNIT PAPER NUMBER

2854

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,968

Applicant(s)

MIYAZAKI, TAKAO

Examiner

Charles H Nolan, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

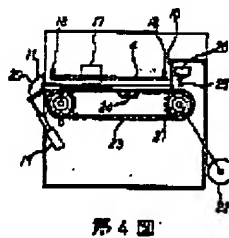
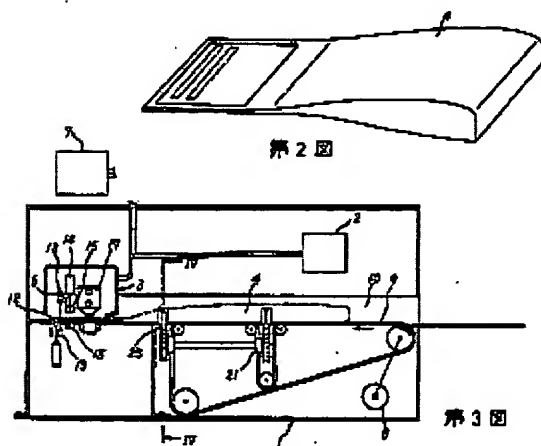
2. Claims 21,23 and 25,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura. With respect to Claims 21 and 23, Kimura teaches the bag onto which printing content is printed by a printing device in the Purpose of the Abstract, the bag comprising a first mark (bar code) in the Purpose of the Abstract and Constitution of the Abstract. Kimura teaches all the claim limitations except that the first mark defines a transport direction to said printing device. However, the Examiner has not given the recitation after "wherein" in Claim 21 any patentable weight because it merely states the result of the limitations in the claim and adds nothing to the claim because the mark alone can not define a transport direction. One of ordinary skill in the art would realize that marks require scanning and decoding which is not recited in Claim 21. Applicant's attention is invited to *Texas Instruments v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993), *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002) and *Amazon.com Inc. v. Barnesandnoble.com*, 57 USPQ2d (Fed. Cir. 2001) for discussions on "wherein" and "whereby" clauses. With respect to Claim 25, Kimura teaches that the bag 4 of Kimura has a layer adopted to be printed by a printing technology 3 in figure 3 and the Constitution of the Abstract. Further, Kimura teaches a

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top surface 4 which the print head 3 faces and a bottom folded surface in his figures. It is noted that the bag of Kimura in figure 2 is folded. Note the curved fold in figure 2.

With respect to new Claim 30, Kimura teaches the first end and second end in figure 2. The Examiner has annotated this Office Action with the figures of Kimura for Applicant's convenience:

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura.

With respect to Claim 22, Kimura teaches a mark (barcode), but does not teach that a second mark is used to identify the bag material. However, it would have been obvious to one of ordinary skill in the art to use the mark of Kimura to identify the bag material as an aesthetic design feature not affecting the structure of the bag. With respect to Claim 24, Kimura teaches that the mark is a barcode in the Purpose of the Abstract.

5. Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Buinevicius et al. (WO 99/49408).

With respect to Claim 22, Kimura teaches all the claim limitations except that the mark (barcode) indicates a bag material. Buinevicius teaches that a mark (barcode) may indicate a bag (flexible packaging) material in the Advantage. It would have been obvious to one of ordinary skill in the art to use a mark (barcode) to indicate the bag material to facilitate inventory control as taught by Buinevicius in the Advantage. With respect to Claim 24, Kimura teaches that the mark is a barcode in the Purpose of the Abstract.

Response to Arguments

6. Applicant's arguments filed 9-10-04 have been fully considered but they are not persuasive. In the response dated 9-10-04, Applicant argues that newly amended claims 21 or 25 are not taught by the prior art of record. The Examiner has pointed out where the prior art of record teaches or renders obvious the newly amended claim language in paragraph 2 of this Office Action.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

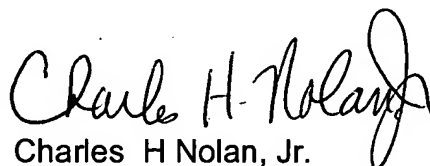
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 571-272-2171. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles H Nolan, Jr.
Primary Examiner
Art Unit 2854

CHN